

REMARKS

Claims 1-3 and 5-13 are pending in the present application. Claims 2, 3, and 5-13 are allowed as set forth at pages 3-4 of the Official Action. Claim 1 is rejected.

Claim Rejections - 35 USC §101

At pages 2-3, claim 1 is rejected under 35 USC §101 as directed to non-statutory subject matter. Specifically, the Office asserts that the preamble of claim 1 recites “A system”. Applicant respectfully disagrees in that the preamble of claim 1 recites “A method of billing, by a third party, for access by a consumer to information made available by a vendor over a computer network, with the billing based on how long the consumer elects to access the information, the method comprising the steps of...”. No reference to “A system” is present in the preamble of claim 1.

The Office further asserts that the preamble fails to give “life, meaning, vitality” to the claim as a whole and that “the steps of ‘when a consumer visits...’ and ‘having a third party...’, which comprise the claim as a whole are mere steps in the abstract without setting forth a practical application for producing any useful, concrete, and tangible result”. Reference is made to the Interim Guidelines IV (C)(1,2). Applicant notes that the recent decision of *In re Bilski* 545 F.3d 943, 88 USPQ2d 1385, 1394-95 (CAFC 2008) (*en banc*) has specifically held that the “useful, concrete, and tangible result” inquiry is inadequate as a test for determining patentable subject matter. Specifically, the Court states:

The second articulation we now revisit is the “useful, concrete, and tangible result” language associated with State Street, although first set forth in Alappat. State St., 149 F.3d at 1373 (“Today, we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a [patent]eligible invention] because it produces ‘a useful,

concrete and tangible result'..."); Alappat, 33 F.3d at 1544 ("This is not a disembodied mathematical concept which may be characterized as an 'abstract idea,' but rather a specific machine to produce a useful, concrete, and tangible result."); see also AT&T, 172 F.3d at 1357 ("Because the claimed process applies the Boolean principle to produce a useful, concrete, tangible result without pre-empting other uses of the mathematical principle, on its face the claimed process comfortably falls within the scope of §101."). The basis for this language in State Street and Alappat was that the Supreme Court has explained that "certain types of mathematical subject matter, standing alone, represent nothing more than abstract ideas until reduced to some type of practical application." Alappat, 33 F.3d at 1543; see also State St., 149 F.3d at 1373. To be sure, a process tied to a particular machine, or transforming or reducing a particular article into a different state or thing, will generally produce a "concrete" and "tangible" result as those terms were used in our prior decisions. But while looking for "a useful, concrete and tangible result" may in many instances provide useful indications of whether a claim is drawn to a fundamental principle or a practical application of such a principle, that inquiry is insufficient to determine whether a claim is patent-eligible under §101. And it was certainly never intended to supplant the Supreme Court's test. *Therefore, we also conclude that the "useful, concrete and tangible result" inquiry is inadequate and reaffirm that the machine-or-transformation test outlined by the Supreme Court is the proper test to apply.* (emphasis added and footnotes omitted) (*In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385, 1394-95 (Fed. Cir. 2008).

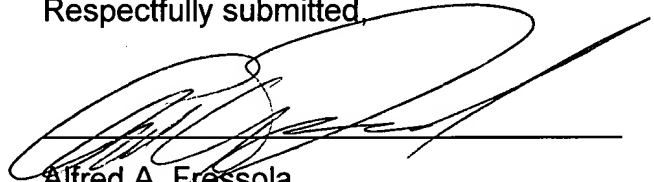
As a result, the basis for the claim rejection is believed to be inappropriate and therefore applicant respectfully requests reconsideration of the rejection of claim 1.

Applicant believes that claim 1 does recite statutory subject matter as interpreted in the Bilski case at least on the basis that the claimed process is tied to a particular machine or apparatus as set forth in the last paragraph of claim 1 (See *In re Bilski*, page 10).

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance and such action is earnestly solicited.

The undersigned respectfully submits that no fee is due for filing this Amendment. The Commissioner is hereby authorized to charge to deposit account 23-0442 any fee deficiency required to submit this paper.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Alfred A. Eréssola', is written over a horizontal line.

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